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OFFICE OF PETITIONS

In re Application of :
Carlton et al. :
Application No. 10/009,145 :
International Filing Date: May 9, 2000 : Decision on Petition for
Attorney Docket No. PU3657USw : Patent Term Extension
For: HIGH THROUGHPUT CRYSTAL :
FORM SCREENING WORKSTATION AND :
METHOD OF USE :

The above-identified application has been forwarded to the undersigned for consideration on a petition entitled "Request for Reconsideration of Calculation Of Patent Term Adjustment," received on October 25, 2005. In the alternative, the petition is being treated as a petition for corrected patent term extension under 37 CFR 1.701 and 37 CFR 1.181. See 35 U.S.C. § 154(b)¹ and 37 CFR § 1.701.

The petition under 37 CFR 1.705 is dismissed.

The petition under 37 CFR 1.181 is dismissed.

Petitioner notes that Notice of Allowance mailed on July 26, 2005, for the above-identified application did not contain an indication of patent term adjustment. Petitioner asserts that the Notice of Allowance improperly stated that the Patent Term Extension is 0 days. Petitioner asserts that from the heading in the Notice of Allowance the United States Patent and Trademark Office improperly calculated patent term extension under 35 U.S.C. § 154(b), however this application was filed after May 29, 2000 and is thus eligible for the patent term adjustment provisions under 35 U.S.C. § 154(b). Petitioner asserts that that the application is entitled to at least 386 days of patent term adjustment under 35 U.S.C. § 154(b)(1)(B).

35 U.S.C. § 154(b)(as amended by the "Uruguay Round Agreements Act," enacted December 8, 1994, as part of Public Law 103-465) provides for patent term extension for appellate review, interference and secrecy order delays in applications filed on or after June 8, 1995 and before May 29, 2000.

¹35 U.S.C. § 154 was amended by the "American Inventors Protection Act of 1999," which was enacted on November 29, 1999 as part of Public Law 106-113 (Consolidated Appropriations Act for Fiscal Year 2000). Since this amendment is effective May 29, 2000 and applies to applications filed on or after that date, the prior patent term adjustment provisions of 35 U.S.C. § 154 continue to apply to the above-identified application.

35 U.S.C. § 154(b)(as amended by the "American Inventors Protection Act of 1999," enacted November 29, 1999, as part of Public Law 106-113) provides for patent term adjustment for these administrative delays and others in applications filed on or after May 29, 2000.

The above-identified application was filed on May 9, 2000, not November 8, 2001, as asserted by Petitioner. The international filing date is the filing date of the application and November 8, 2001, is the date of national stage entry. See MPEP 1893.03(b). Accordingly the application is entitled to patent term extension based upon the conditions in 35 U.S.C. § 154(b), in effect on June 8, 1995. The provisions of 35 U.S.C. § 154(b) in effect on May 29, 2000 do not apply, because the amended version of 35 U.S.C. § 154(b) only applies to applications filed on or after May 29, 2000.

In the alternative, pursuant to 35 U.S.C. § 154(b), in effect on June 8, 1995, the application is not entitled to patent term extension under 37 CFR 1.701, as there was not a successful appeal, interference or a secrecy order. The Office has no authority to grant an extension of the term due to administrative delays except as authorized by 35 U.S.C. § 154.

After mailing of this decision, the above-identified application will be forwarded to the Office of Publications.

The rules and statutory provisions governing the operations of the U.S. Patent and Trademark Office require payment of a fee on filing each petition. *See* 35 U.S.C. § 41(a)(7). Accordingly, as authorized the required \$200 fee for the petition under 37 CFR 1.705(b) has been charged to Petitioner's Deposit Account (07-1392). The petition fee under 37 CFR 1.182 for questions not specifically provided for has not been charged to Petitioner's deposit account.

Telephone inquiries with regard to this communication should be directed to Mark O. Polutta at (571) 272-7709.



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